

REMARKS

Claims 1-4, 6-11, 14, and 17-19 and 21-33 were pending as shown in the paper mailed June 7, 2004.

Restriction as between 18 different Groups is now required. In particular, all of the pending claims were classified in 18 different groups. Each group includes a single functional domain set forth in dependent claims 14 and 33.

Applicants traverse the Restriction Requirement and supporting remarks.

It is well settled that two criteria must be met for a proper restriction requirement under M.P.E.P. § 803: (1) the inventions must be independent or [*sic*] distinct as claimed; and (2) there must be a serious burden on the Examiner if restriction is not required. Applicant respectfully submits that the Examiner has not met either criterion.

With regard to the first criterion, the Office asserts that "each of the inventions of Groups I-XVIII requires an additional separate search directed to specific protein functional domains...." However, the specific protein functional domains appear only in dependent claims 14 and 33 and no reasons are given with regard to independence or distinctness of independent claims 1 and 21. Indeed, the Office acknowledges that the independent claims (claims 1 and 21) are not patentably distinct from each other, as they are classified in all of the 18 allegedly distinct Groups. Simply put, the Office has not established that the "inventions" of Groups I-XVIII are independent and distinct.

Applicants also traverse on the grounds that the second criterion (unduly burdensome search requirement on the Office) has not been met. Any search for references relevant to the subject matter of independent claims 1 and 21 (classified in all 18 Groups) will **necessarily and in all cases** reveal art relevant to all claims, including modified plant zinc finger proteins comprising the various functional domains recited dependent claims 14 and 33, which form the basis of the Restriction. There is no need to search for references relevant to the various functional domains, as they are not claimed independently of their association with a modified plant ZFP.

Thus, the proper search for the pending claims is a search for references relevant to modified plant ZFPs, as set forth in claims 1 and 21. Indeed, the necessary search for references relevant to modified ZFPs has already been conducted, as evidenced by the substantive examination in this case that preceded the filing of the RCE on June 7, 2004. Therefore, not only do the various functional domains not need to be searched separately, the proper and relevant search for the subject matter of the independent claims has already been conducted.

In sum, the Restriction Requirement cannot stand because the two criteria of M.P.E.P. § 803 (*i.e.*, distinctness and undue search burden) have not been fulfilled.

Solely for the purposes of compliance with 37 C.F.R. § 1.143, Applicants elect, **with traverse**, Group IX, drawn to a composition comprising or encoding a modified zinc finger protein and a C1 functional domain.

Applicants expressly reserve their right to petition the Restriction Requirement if it is made FINAL and also reserve their right under 35 USC § 121 to file one or more continuing applications directed to the nonelected subject matter during the pendency of this application.

Respectfully submitted,

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regard to independence or distinctness of independent claims 1 and 21. Applicant also maintains that the Office acknowledges that the independent claims (claims 1 and 21) are not patentably distinct from each other, as they are classified in the same class and subclass.

This is not found persuasive because dependent claims may be restricted when they are directed to independent or distinct inventions. This is also not found persuasive because, as set forth at page 6 of the office action mailed May 10, 2005, the specific protein functional domains (p300, CBP, PCAF, SRC1, PvALF, ERF-2, OsGAI, HALF-1, C1, AP1, ARF-5, ARF-6, ARF-7, ARF-8, CPRF1, CPRF4, MYC-RP/GP and TRAB1) are distinct because they originate from different species of organisms and because they differ both structurally and functionally. This is additionally not found persuasive the classification of claims in the same class and subclass does not suggest that the subject matter of the claims is not patentably distinct, as every class and subclass contains numerous different inventions that are patentably distinct from each other.

The traversal is also on the ground(s) that a search of the restricted groups would not pose a serious burden. Applicant points out that any search for references relevant to the subject matter of independent claims 1 and 21 (classified in all 18 Groups) will necessarily and in all cases reveal art relevant to all claims, including modified plant zinc finger proteins comprising the various functional domains recited dependent claims 14 and 33. Applicant maintains that there is no need to search for references relevant to the various functional domains, as they are not claimed independently of their association with a modified plant ZFP.

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This is not found persuasive because references relevant to the various functional domains must be searched separately from their association with a modified plant ZFP even though they are not claimed independently. A proper search is not limited to the subject matter of the independent claims, as relevant art not identified in a search of the independent claims, such as art useful under 35 USC 103, may exist.

The requirement is still deemed proper and is therefore made FINAL.

Claim Rejections - 35 USC § 112

Claims 1-4, 6-11, 14, 17-19 remain rejected, and claims 21-33 are rejected, under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention, for the reasons of record.

Applicant's arguments filed June 10, 2004, have been fully considered but they are not persuasive.

Applicant maintains that the pending claims are directed to molecules clearly described in the specification as filed. Applicant points out that the claims have been amended to make explicit that the claimed modified plant zinc finger proteins necessarily have a different amino acid sequence than naturally occurring plant zinc finger proteins, either because the inter-finger spacing is shortened (claim 1 and claims dependent therefrom) and/or because the amino acid sequence of the recognition region is altered as compared to a naturally occurring zinc finger protein (claim 21 and claims dependent

Xenopus TFIIIA” have the same chemical composition, i.e. they each are composed of amino acids. Further, “not derived from zif268 or Zif268 or *Xenopus* TFIIIA” does not indicate what the particular amino acid sequences or structures the claimed zinc finger proteins exhibit, or whether those sequences and structures in fact differ from those of Barbas.

With respect to claims 21-30 and 32, Applicant maintains that Barbas et al. does not anticipate or render obvious the invention as currently claimed, because the claimed proteins have naturally occurring plant zinc finger protein sequences in their backbone, whereas Barbas teaches only proteins comprising Cys2-His2 zinc fingers obtained from murine Zif268 or *Xenopus* TFIIIA. Applicant maintains that Barbas’s proteins thus differ in sequence from those claimed, and therefore in structure as well.

The Examiner first maintains that rejected claims do not require the presence of naturally occurring plant zinc finger protein sequences in their backbone. Second, the presence of naturally occurring plant zinc finger protein sequences in the backbone of the claimed zinc finger proteins would not impose specific sequence or structural limitations on the claimed zinc finger proteins that would allow them to be distinguished from the zinc finger proteins of Barbas. Zinc finger proteins comprising naturally occurring plant zinc finger protein sequences in their backbone are not distinguishable from those of Barbas, because naturally occurring plant zinc finger protein sequences and a zinc finger backbone “derived from zif268 or Zif268 or *Xenopus* TFIIIA” have the same chemical composition, i.e. they each are composed of amino acids. Further, “naturally occurring plant zinc finger protein sequences” would not indicate what